

RECEIVED  
CENTRAL FAX CENTER

DEC 07 2007



# RYLANDER & ASSOCIATES PC

*Trial & Patent Attorneys*  
406 West 12<sup>th</sup> Street  
Vancouver, WA 98660

**CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8**  
I hereby certify that this correspondence is being facsimile  
transmitted to the United States Patent and Trademark Office  
on December 7, 2007.

KURT M. RYLANDER, U.S. Reg. No. 43,897

**Telecopier No. 360.397.0473**

If there is a problem with transmission or if all pages are not received, please call 360.750.9931.

**TO:** MAIL STOP APPEAL BRIEF-PATENTS **FAX # (571) 273-8300**  
**COMPANY:** COMMISSIONER OF PATENTS

**ATTN:** BRIDGET C. MONROE, Patent Appeal Center Specialist

**FROM:** KURT RYLANDER **DATE:** December 07, 2007

Docket No. WILB01  
In re application of Brian R. Will  
Serial No. 10/608408  
Filed: June 27, 2003  
For: EYE FIXATION APPARATUS

Examiner: David M. Shay  
Group Art Unit: 3735

Number of pages including this cover page: 9

This message is intended only for the use of the individual or entity to which it is addressed, and may contain information that is PRIVILEGED, CONFIDENTIAL and exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone, and return the original to us by mail without making a copy. Thank you.

Enclosed: RESPONSE TO NOTICE OF NON-COMPLIANT BRIEF (8 pages)

RECEIVED  
CENTRAL FAX CENTER

DEC 07 2007

US PATENT APPLICATION  
Docket No. WILB01

IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

Application of: BRIAN R. WILL

Serial No. 10/608408  
Filed: June 27, 2003

Examiner: Shay  
Group Art Unit: 3739

For: EYE FIXATION APPARATUS

Date: December 7, 2007

**RESPONSE TO NOTICE OF NON-COMPLIANT BRIEF**

This Supplemental Brief of the Appellant is submitted in response to the Notification of Non-compliant Brief mailed November 9, 2007. The Notification stated that only the sections of the Appeal Brief relating to the STATUS OF CLAIMS, SUMMARY OF CLAIMED SUBJECT MATTER, and GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL required supplementation and so only those corrected sections are included herein. This Response with corrected sections is timely filed within 30 days of the mailing date of the Notification. The corrected STATUS OF CLAIMS begins on page 3 of this Response. The corrected SUMMARY OF CLAIMED SUBJECT MATTER begins on page 4 of this Response. The corrected GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL begins on page 7 of this Response.

**SUMMARY OF INTERVIEWS**

Applicant's attorney, Mark Beatty, USPTO Registration No. 60,623, spoke with Examiner Shay regarding the Notice of Non-Compliant Brief on November 16, 2007. Applicant felt that the original Brief did comply with the rules and requested clarification.

Examiner Shay explained that he had not examined the Brief, that the Notice came from a different office, and provided the extension for Appeals Specialist Bridget Monroe.

Mr. Beatty left a voice mail for Appeals Specialist Monroe requesting clarification on how to respond. Ms. Monroe returned the call on November 16 and stated that Applicant need only correct the specific sections referenced in the Notice of Non-compliance and not submit a new brief. She stated that the brief should have a concise statement that is mapped to the Specification by page and line numbers, or at the very least with paragraph numbers.

#### **CORRECTIONS TO BRIEF**

Below are corrected sections which Applicant submits in response to the Notice of Non-compliant Brief. Only the sections titled STATUS OF CLAIMS, SUMMARY OF CLAIMED SUBJECT MATTER, and GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL are included because these were the only sections referenced in the Notice of Non-compliant Brief.

**STATUS OF CLAIMS (corrected section)**

Claims 1-22 were rejected. All rejections are appealed. No amendments were made to any claims after final rejection. All claims 1-22 are now pending.

Prior to this Response, a Final Office Action rejecting all claims was mailed April 11, 2007, responding to Applicant's RCE which included an affidavit submission under 37 C.F.R. 1.132 and adding new claim 22, dated January 12, 2007. The prior final rejection was withdrawn and a new rejection entered by Examiner. Applicant timely filed a Notice of Appeal with applicable fees on June 22, 2007.

Claims 1-22 were rejected under § 112 second paragraph for indefiniteness. Claims 1-13 were rejected for the first time under § 112.

Claims 1, 11, and 12 were finally rejected under 35 U.S.C. § 103(a) as unpatentable over EP 0372127A1 to L'Esperance or US 6,042,594 to Hellenkamp.

Claims 2 and 13 were finally rejected under § 103(a) as unpatentable over L'Esperance or Hellenkamp, in combination with US 4,173,980 to Curtin.

Claims 3, 4, 7, 8, 14-16, 18, and 19 were finally rejected under § 103(a) as unpatentable over L'Esperance or Hellenkamp in combination with Curtin or Clark et al.

Claims 5, 6, 9, 10, 17-22 were finally rejected under § 103(a) as unpatentable over L'Esperance or Hellenkamp, in combination with Curtin and Clark et al, and further in combination with US 5,613,061 to Olson.

**SUMMARY OF CLAIMED SUBJECT MATTER (corrected section)**

The present invention relates generally to devices and methods for fixating eyes for ophthalmic surgery, and more particularly to eye fixation devices and methods using vacuum pressure for fixation for guiding a surgical tool or laser.

Claims 1, 11 and 22 are independent claims.

Independent claim 1 relates to a novel apparatus for fixating the eye. The apparatus is convex, matching the convex profile of the cornea. *See Specification at 6 II.1-9; Figs. 1, 3 & 4 #10, #12, #14 and #16.* The interior eye-fixation part of the apparatus includes a convex contact surface for contacting the surface of the eyeball encircling the cornea. *Id.* The eye fixation portion includes a convex contact portion which encircles the cornea, contacting the corneal surface via the lands between criss-cross vacuum distribution channels. *See Specification at p.6 II.9 – p.7 II.11; Figs. 3 & 4 #16.* A vacuum port is provided in communication with the criss-crossing channels to draw the eyeball membrane to the contact portion. *See Specification p.6 II.14-20; Figs. 1, 2, 3 & 5 #14, #16 and #18.* Claims 2-9 depend from claim 1.

Claim 2 includes adjustment arms which allow the surgeon to use both hands to adjust the eye fixation device in relation to the eyeball before applying vacuum, while sighting through the device. *See Specification p.7 II.18-21; Figs. 2 & 5 #20.*

Claims 3, 4, 7 and 8 include first and second annular translation guide members (#40 & #60) with translation rods (#50 & #70) and adjustment knobs (#48 & #68), allowing the surgeon to adjust the annular openings laterally to one another (e.g. in perpendicular X-Y axes or non-perpendicular axes), which is what receives surgical instruments or allows application of a surgical laser or other devices, after applying vacuum to fix the fixation apparatus to the eyeball. *See Specification p.7-11; Figs. 1, 2, 5 & 6 #22, #24, #28, #48, #50, #52, #68, #70, #72.* The threaded guide rods allow fine

adjustment of position to fine tune the initial positioning of the device. *Id.*

Claims 5, 6, 9, and 10 include docking screws through the first and second annular translation guide members so that surgical devices, such as laser sighting cones, can be inserted and locked into the annular opening, thereby fixing the surgical devices to the eyeball rather than the eyeball being forced to align with the devices and causing distortion. *See Specification p. 10 I.19 – p.11 I.2; Figs. 1, 2 & 5 #72.*

Independent claim 11 recites a method for using the novel apparatus to provide fixation of the eyeball during ophthalmic surgeries. *See Specification p.11 II.8-19.* Claims 12-21 depend from claim 11.

Claim 12 depends from claim 11 and includes the step of verifying the centering of the eye fixation apparatus and adjusting if necessary by shutting off vacuum, recentering the device, and re-applying vacuum pressure. *See .* Claim 13 depends from claims 11 and 12, and includes the methods of claims 11 and 12 where the apparatus includes adjustment arms (#20). *See Specification p.7 II.18-21; p.11 II.12-17.*

Claim 14 depends from claims 11 and 12, and includes the steps of adjustably connecting a first annular translation guide member to the eye fixation portion to translate the first guide member laterally in relation to the eye fixation portion. This step allows surgical devices to be aligned by inserting them into the first translation guide member and adjusting the guide member while leaving the eye fixated by the fixation portion. *See Specification p.7 I.22 – p.9 I.8; p.11.*

Claim 15 depends from claim 14 and includes using a translation rod and adjustment knob to provide fine control when applying linear adjustments to the first translation guide member. *See Specification p.8 I.18 – p.9 I.8; p.11.*

Claims 16 and 17 depend from claims 13 and 14 respectively, and include the step of tightening the first translation guide member against objects inserted into the

cylindrical space of the first annular translation guide member using a docking screw through first translation guide member. This step allows positive capture of surgical devices in the first translation guide member. *See Specification p.10 l.19 – 11 l.2; p.11.*

Claim 18 depends from claim 14 and includes adjustably connecting a second translation guide member to the first translation guide member to provide a second non-parallel axis for adjusting surgical devices to the fixated eyeball. *See p.9 l.9 – p.10 l.17; p.11.*

Claims 19, 20 and 21 depend from claim 18 and mirror the steps recited in claims 15 through 17 relating to the first translation guide member but applied to the second translation guide member. *See p.9 l.9 – p.10 l.17; p.11.*

Independent claim 22, which was newly added in the RCE, incorporates the limitations of Claims 1-10 and explicitly recites a narrow profile which fits under a patient's lid without need for a lid speculum. Applicant felt this limitation was inherent in the original claims as recited, when read in light of the Specification and Drawings, but added claim 22 with an explicit limitation to address Examiner's arguments. *See p.4 ll.11-21; pp. 6-11; Figs. 2, 3 &4.*

**GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (corrected section)**

All claim rejections are appealed.

1. Whether claims 1-22 are invalid under 35 U.S.C. § 112 second paragraph.
2. Whether claims 1, 11 and 12 are unpatentable under 35 U.S.C. § 103(a) over EP 0372127A1 to L'Esperance or 6,042,594 to Hellenkamp.
3. Whether claims 2 and 13 are unpatentable under 35 U.S.C. § 103(a) over L'Esperance or Hellenkamp, in combination with US 4,173,980 to Curtin.
4. Whether Claims 3, 4, 7, 8, 14, 15, 18, and 19 are unpatentable under § 103(a) over L'Esperance or Hellenkamp in combination with Curtin and/or Clark et al, and further in view of Ruiz.
5. Whether Claims 5, 6, 9, 10, 16, 17, 18 and 19 are unpatentable under § 103(a) over L'Esperance or Hellenkamp, in combination with Curtin and/or Clark et al, and further in combination with US 5,613,061 to Olson.
6. Whether claim 22 is unpatentable under § 103(a) over L'Esperance or Hellenkamp, in combination with Curtin and/or Clark et al, and further in combination with US 5,613,061 to Olson.
7. Whether claims 11-21 are unpatentable under § 103(a) over L'Esperance or Hellenkamp, in combination with Curtin and/or Clark et al, and/or Ruiz and/or Olson.

**CONCLUSION**

Applicant believes the Brief with corrected sections is in compliance and respectfully requests the corrected sections be admitted.

Respectfully submitted,  
**RYLANDER & ASSOCIATES PC**

---

KURT M. RYLANDER  
USPTO Reg. No. 43,897  
406 West 12<sup>th</sup> Street  
Vancouver, Washington 98660  
(360) 750-9931